

REMARKS

This is an amendment under 37 CFR §1.116. The amendments and specific arguments herein, to the extent they were not presented earlier, are now presented because they are necessitated by the arguments made by the Examiner in the last office action. It is submitted that these amendments do not raise new issues and do not require any further searching.

Since this response has been filed within two months of the mailing date of the Final Rejection, in the event that the Examiner does not issue a Notice of Allowability, a timely Advisory Action is requested.

Claims 7-9 and 10-12 have been added. New claims 7-9 and 10-12, dependent on original claims 5 and 6, respectively, are directly parallel to original claims 2-4, dependent on original claim 1. These claims have been added merely to cover different forms of the invention. Because the added claims are directly parallel to original claims, it is respectfully submitted that the addition of these claims does not raise new issues requiring further searching.

Turning now to the rejection, it is respectfully submitted that the obviousness rejection is a result of an improper application of the obviousness standard. In particular, in responding to Applicant's arguments, the Examiner states that the motivation for modifying Elliot to assert the user interface task for user-specified position is "because it allows user composition of screen layout, and this should not contrary to Elliott's invention, reason is that user-specified position task would gives user an alternate option without departing from the main principle and scope." See page 4 of the Office Action.

It is respectfully submitted that this statement on the part of the Examiner clearly exhibits the Examiner's misunderstanding and misapplication of the obviousness standard. That is, by the Examiner's reasoning, any modification to a primary reference that "allows" a user to perform an additional function "without departing from the main principle and scope" would automatically be obvious. This is most certainly not the standard. Rather, "the mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." In re Laskowski, 10 USPQ2d 1397

(Fed. Cir. 1989). This is so even though the primary reference "could readily be modified".

But here, the Examiner has not pointed to anything in any reference that suggests the desirability of the modification. The Examiner merely states, in so many words, that the modification "may be" made. If the Examiner continues to reject the claims as being obvious, the Examiner respectfully requests the Examiner to point out where the prior art suggests the modification proposed by the Examiner. What the Examiner appears to be doing is looking at Applicant's specification, determining that a prior art reference "could be so modified" to yield the invention, stating the result of the modification and, from all that, making an incorrect determination that the invention is obvious. What the Examiner is doing in this case is using impermissible hindsight, plain and simple. The reason for modifying a primary reference "can not come from the applicant's invention itself".

Because the reason given by the Examiner for modifying the primary reference comes from Applicant's claim itself (i.e., there is no suggestion in the reference or other art -- at least none that the Examiner has indicated -- to make the modification), the obviousness rejection is improper and must be withdrawn.

CONCLUSION

For the foregoing reasons it is submitted that all of the claims are now in condition for allowance and the Examiner's early re-examination and reconsideration are respectfully requested.

Respectfully submitted,

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